

ESTTA Tracking number: **ESTTA465929**

Filing date: **04/07/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92055106
Party	Defendant Tony Chavez
Correspondence Address	TONY CHAVEZ 22702 PEACH COURT SANTA CLARITA, CA 91390 UNITED STATES kdallara@dallara.com
Submission	Answer
Filer's Name	Ken Dallara
Filer's e-mail	kdallara@dallara.com
Signature	/ken dallara/
Date	04/07/2012
Attachments	CCF00462012_00000.pdf (6 pages)(3797961 bytes)

In Re Registration Number :	3,635,144
Registration Date :	June 9, 2009
Cancellation Filing Date:	January 27, 2012
Cancellation Case Number :	92/055,106
Respondent's Mark :	STONEY STRAPS PULL YOUR PANTS DOWN and Design
Petitioner's Refused Mark :	LET DIRTY EDDIE PULL YOUR PANTS DOWN
Petitioner's Application Number :	85/298,038

Petitioner,

RESPONDENTS ANSWER AND
AFFIRMATIVE DEFENSES
TO PETITIONER' S
PETITION FOR CANCELLATION

Respondent,

RESPONDENT'S ANSWER

1) Except as expressly admitted below, Respondent denies all allegations contained in the Petitioner's Petition for Cancellation.

- 2) Respondent lacks sufficient knowledge about or information contained therein to form a belief as to the truth of the allegations contained in paragraph 1 of the Petitioner's Petition for Cancellation.
- 3) Respondent admits the allegations contained in paragraph 2 of the Petitioner's Petition for Cancellation.
- 4) Respondent denies the allegations contained in paragraphs 3 through 8 of the Petitioner's Petition for Cancellation.
- 5) Respondent denies the allegations contained in paragraphs 9 through 11 of the Petitioner's Petition for Cancellation.
- 6) Respondent denies the allegations contained in paragraph 12 of the Petitioner's Petition for Cancellation.
- 7) Respondent denies the allegations contained in paragraphs 13 through 17 of the Petitioner's Petition for Cancellation.

AFFIRMATIVE DEFENSES

Respondent, without admitting or acknowledging that Respondent bears the burden of proof as to any of them and through it's information and belief, asserts, on that basis, the following affirmative defenses;

- A. Respondent's first and separate affirmative defense, Petitioner's Claims, in whole or as to specific allegations, fails to state a claim which relief may be granted.

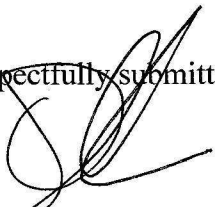
- B. Respondent's second and separate affirmative defense, Respondent has rights in its Mark STONEY STRAPS PULL YOUR PANTS DOWN superior to those in Petitioner's claimed mark.
- C. Respondent's third and separate affirmative defense, there is and can be no likelihood of confusion, mistake, deception, false suggestion of connection nor potential damages as alleged by Applicant because Respondent's Mark, STONEY STRAPS PULL YOUR PANTS DOWN, is visually distinct from Applicant mark.
- D. Respondent's fourth and separate affirmative defense, there is and can be no likelihood of confusion, mistake, deception, false suggestion of connection nor potential damages as alleged by Applicant because Respondent's Mark, STONEY STRAPS PULL YOUR PANTS DOWN, is distinct in sound, appearance and connotation and for other reasons are not confusingly similar to Petitioner's marks and vice versa.
- E. Respondent's fifth and separate affirmative defense, Petitioner's Petition is barred from recovery under the doctrine of laches.
- F. Respondent's sixth and separate affirmative defense, Petitioner's Petition is barred from recovery under the doctrine of unclean hands.
- G. Respondent's seventh and separate affirmative defense, Petitioner's Petition is barred from recovery under the doctrine of acquiescence.
- H. Respondent's eighth and separate affirmative defense, Petitioner's Mark is merely descriptive as it conveys the product's characteristic and is thus barred from registration under Section 2 (e) (1) of the Lanham Act.
- I. Respondent's ninth and separate affirmative defense, Petitioner's Mark is non-distinctive and does not carry a secondary meaning, and is thus barred from registration under Section 2 (e) (1) of the Lanham Act.

- J. Respondent's tenth and separate affirmative defense, Petitioner's Petition is barred from recovery under the doctrine of waiver.
- K. Respondent's eleventh and separate affirmative defense, Petitioner's Petition is barred from recovery under the doctrine of collateral estoppel.
- L. Respondent's twelfth and separate affirmative defense, Petitioner's Petition is barred from recovery under the doctrine of fraud.
- M. Respondent's thirteenth and separate affirmative defense, Petitioner's Petition is barred from recovery under the doctrine of fair use as defined by Section 33 of the Lanham Act, as codified under 15 U.S.C. 1115(b)(4), which provides a safe harbor for fair use for a potential trademark infringer where "the use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark...of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party".
- N. Respondent's fourteenth and separate affirmative defense, Petitioner's Petition is barred from recovery under the doctrine of equitable estoppel.
- O. Respondent's fifteenth and separate affirmative defense, Petitioner's Petition is barred from recovery under the doctrine of res judicata.
- P. Respondent's sixteenth and separate affirmative defense, Petitioner's Petition is barred from recovery under the doctrine of abandonment of his proposed Mark.
- Q. Respondent's seventeenth and separate affirmative defense, Petitioner's Petition is barred from recovery by Petitioner's contractual consent for Respondent's use of his Mark in commerce.
- R. Respondent's eighteenth and separate affirmative defense, Petitioner's Petition is barred from recovery as he has not disclosed a reasonable belief in the damages.

- S. Respondent's nineteenth and separate affirmative defense, Petitioner's Petition is barred from recovery as Petitioner does not have proprietary rights to the proposed Mark.
- T. Respondent's twentieth and separate affirmative defense, Petitioner's Petition is barred from recovery as Petitioner has waived his rights to cancel or object to or to interfere with the registration and Respondent's use of his Mark.
- U. Respondent's twenty-first and separate affirmative defense, Petitioner's Petition is barred from recovery as Petitioner has contractually waived his rights to cancel or object to or to interfere with the registration and Respondent's use of his Mark.
- V. Respondent's twenty-second and separate affirmative defense, Petitioner's Petition is barred from recovery as Petitioner lacks standing to petition to cancel Respondent's Registered Mark.
- W. Respondent reserves the right to rely on all matters constituting an avoidance or affirmative defense to the extent that such defenses are supported by information developed through discovery or by evidence during testimony or at trial.

THEREFORE, Respondent respectfully requests that Petitioner's Petition for Cancellation be denied and that Petitioner's Petition be dismissed with prejudice.

Respectfully submitted,



Ken Dallara, Esq.,
Attorney for Respondent, Tony Chavez

Dated : 4/6/12

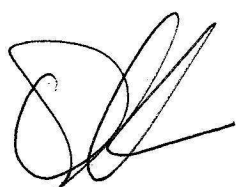
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CERTIFICATE OF SERVICE

1) I hereby certify that a copy of the RESPONDENT'S ANSWER AND AFFIRMATIVE DEFENSES TO PETITIONER'S PETITION FOR CANCELLATION was caused to be transmitted to the Trademark Trial and Appeal Board via the ESTTA electronic filing system on 4/6/12.

2) I hereby certify that a copy of the RESPONDENT'S ANSWER AND AFFIRMATIVE DEFENSES TO PETITIONER'S PETITION FOR CANCELLATION was served upon aforementioned counsel by depositing it with the United States Post Office, postage prepaid, on 4/7/12 via First Class Mail to the following recipient:

Mr. Evan Anderson
Patel & Alumit PC
16830 Ventura Blvd, Suite 360
Encino, California 91436

By : 
Ken Dallara, Esq - Attorney for Applicant – Tony Chavez